

Response to Office Action
Serial No. 09/978,454
Page 3 of 6

030727.0027.CON1

177. (Once Amended) The pharmaceutical composition of Claim 171, wherein MH is araC and V is a heteroaryl group.

*E-4
Cont*

178. (Once Amended) The pharmaceutical composition of claim 177, wherein V is 4-pyridyl.

179. (Once Amended) The pharmaceutical composition of claim 172 wherein MH is 2'-deoxy-5-¹²⁵I-iodouridine.

REMARKS

Claims 168-185 are pending in this Application. Claims 168-185 are subject to an Election of Species Requirement.

Claims 169-179 were amended to comply with the Examiner's renumbering of the claims. As such, the amendments do not constitute new matter. In accordance with 37 C.F.R. § 1.121, a marked up copy of the presently amended claims is appended hereto. Additions are noted by underlining. Deletions are noted by bracketing. Furthermore, to ensure that Applicants' pending claims match those of the Patent Office, a clean copy of the entire set of pending claims is also appended hereto.

Election of Species Requirement

The Examiner contends that "claims 168-185 are generic to a plurality of patentably distinct species comprising phosphorous-containing compounds." (Office Action p. 2) The Examiner requires that the Applicants elect a single disclosed species.

The Applicants respectfully contend that the claimed compounds of Formula I present sufficiently few species and that they can be readily evaluated together. Indeed a search of any of the species of the allegedly generic claims would, by necessity, include a search of art relevant to the other

Response to Office Action
Serial No. 09/978,454
Page 4 of 6

030727.0027.CON1

species of such claims. The Applicants submit that such a search would not be an undue burden on the Examiner.

In view of the above, Applicants respectfully request removal of the election of species requirement. The Applicants further understand that claims drawn to nonelected species will no longer be withdrawn if any generic claim is found to be allowable.

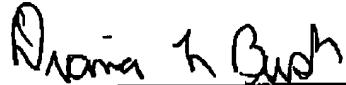
In order to be fully responsive, the Applicants hereby elect the following species, with traverse. The elected species is a compound of Formula I, wherein MH is araC; Z, W, and W' are hydrogen; and V is 4-pyridyl.

The Applicants believe that claims 168, 171, 174, 175-178, 181, and 183 are drawn to the elected species.

Respectfully Submitted,

Date: 1/21/03

By:


Diana L. Bush
Reg. No. 51,109

Brobeck, Phleger & Harrison LLP
12390 El Camino Real
San Diego, CA 92130-2081
Direct Dial: (858)720-2500
Facsimile: (858)720-2555

Response to Office Action
Serial No. 09/978,454
Page 5 of 6

030727.0027.CON1

MARKED UP COPY OF THE AMENDED CLAIMS

169. (Once Amended) The pharmaceutical composition of claim [2]168, wherein MH is 9-(2-phosphonylmethoxyethyl)adenine (PMEA) or analogues thereof.

170. (Once Amended) The pharmaceutical composition of claim [2]168, wherein MH is 9-(2-phosphonylmethoxyethyl)adenine (PMEA).

171. (Twice Amended) The pharmaceutical composition of claim [2]168, wherein MH is selected from penciclovir, 3TC, ACV, PMPA, araC, ribavirin, fludarabine, and 5-fluoro-2'-deoxyuridine.

172. (Once Amended) The pharmaceutical composition of claim [2]168, wherein MH is radiolabelled 2'-deoxy-5-iodouridine.

173. (Once Amended) The pharmaceutical composition of claim [6]172 wherein MH is 2'-deoxy-5-¹³¹I-iodouridine.

174. (Once Amended) The pharmaceutical composition of claim [2]168, wherein V is selected from the group consisting of aryl, substituted aryl, heteroaryl, and substituted heteroaryl.

175. (Once Amended) The pharmaceutical composition of claim [2]168, wherein the prodrug is in the *cis* configuration.

176. (Once Amended) The pharmaceutical composition of claim [8]174, wherein the prodrug is in the *cis* configuration.

177. (Once Amended) The pharmaceutical composition of Claim [5]171, wherein MH is araC and V is a heteroaryl group.

178. (Once Amended) The pharmaceutical composition of claim [11]177, wherein V is 4-pyridyl.

Response to Office Action
Serial No. 09/978,454
Page 6 of 6

030727.0027.CON1

179. (Once Amended) The pharmaceutical composition of claim [6]¹⁷² wherein MH is
2'-deoxy-5-¹²⁵I-iodouridine.